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No. 84-

# In the Supreme Court of the United States

**October Term, 1984**

NESTIER CORPORATION,
*Petitioner,*

vs.

MENASHA CORPORATION
(Lewisystems Division),
*Respondent.*

## PETITION FOR WRIT OF CERTIORARI
**To the United States Court of Appeals**
**For the Federal Circuit**

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48 pp

## QUESTIONS PRESENTED

1. Whether the court below improperly emasculated the test of patent infringement set forth by this Court in *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U.S. 605 (1950).

2. Whether the presence at trial of a properly demanded and impanelled jury allows a court to remove from the jury consideration of selected factual issues as to patent infringement notwithstanding the guarantees of the Seventh Amendment?

## THE PARTIES

All parties are listed in the caption. The current successor to "Nestier Corporation" is "Buckhorn Material Handling Group, Inc." Pursuant to Rule 28.1, Petitioner discloses that all parties have no subsidiaries from which business is transacted.

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## PETITION FOR WRIT OF CERTIORARI
**To the United States Court of Appeals**
**For the Federal Circuit**

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Nestier Corporation ("Nestier") respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit entered in this case on August 1, 1984.

## OPINIONS BELOW

The opinion of the Court of Appeals is officially reported at 739 F.2d 1576 (Fed. Cir. 1984) and unofficially reported at 222 U.S.P.Q. (BNA) 747 (Fed. Cir. 1984). The October 17, 1984 Order of the Court of Appeals declining Nestier's suggestion for Rehearing *En Banc* is not reported. The judgments of the District Court have not been reported. The opinion and order of the Court of Appeals, and the judgment and order of the District Court are reprinted in the Appendix.

## JURISDICTION

The judgment of the Court of Appeals was entered on August 1, 1984, and the order of the Court of Appeals denying Nestier's petition for rehearing and declining the suggestion for Rehearing *En Banc* was entered on October 17, 1984. (Appendix A21 (hereinafter "App. .....").) This Court has jurisdiction to review the decision of the Court of Appeals by writ of certiorari pursuant to 28 U.S.C. § 1254(1).

## CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

United States Constitution, Article I, Section 8, clause 8 provides:

> The Congress shall have Power. . .
>
> To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

United States Constitution, Amendment VII provides:

> In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law.

35 U.S.C. § 271 (1984) provides in pertinent part:

> (a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any

patented invention, within the United States during the term of the patent therefor, infringes the patent.

35 U.S.C. § 281 (1984) provides:

A patentee shall have remedy by civil action for infringement of his patent.

35 U.S.C. § 282 (1984) provides in pertinent part:

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement, or unenforceability, . . . .

## STATEMENT OF THE CASE

Nestier instituted this action for infringement of its Letters Patent No. 3,463,345 in United States District Court for the Southern District of Ohio. Nestier demanded a trial by jury.

Petitioner's patent is directed to the art of reusable tote boxes, which are stackable with one another when filled, and nestable with one another when empty. More specifically, the patent is directed to a novel tote box structure including attached lids. A copy of Petitioner's patent has been appended hereto as a Supplemental Appendix. Menasha Corporation ("Respondent") introduced a line of tote boxes in competition with Nestier which Nestier believed infringed its patent. A picture of the Menasha box which formed the basis of this action is included in App. A22.

At the commencement of trial, pursuant to the order of the trial court, counsel for Petitioner submitted proposed

jury instructions. Included within Petitioner's proposed jury instructions was an instruction on patent infringement, which included a requested instruction applying the doctrine of equivalents. App. A23.

During the trial, Petitioner's expert testified as to his opinions of direct infringement by Respondent of the Nestier patent in suit. After testifying as to his conclusion of infringement and amidst a series of objections by Menasha's counsel, the expert was asked as to his opinion on the applicability of the doctrine of equivalents insofar as the reading of the Nestier patent claims on the accused Menasha tote box. The expert testified that inasmuch as he found literal or direct infringement, he would not have to reach the issue of the doctrine of equivalents.

Before the charge to the jury, the Court met with counsel to finalize the proposed jury instructions. As noted in Petitioner's proposed jury instructions, App. A23, Petitioner's definition of infringement included the application of the doctrine of equivalents as set out in *Graver Tank, supra*. During the drafting of the jury instructions with the Court, Respondent's counsel objected vehemently to the presence of the requested equivalents instructions. Respondent's counsel proposed, and the Court accepted, the proposition that inasmuch as Petitioner's expert found literal infringement without reaching the issue of the doctrine of equivalents, Petitioner had forfeited its right to have the doctrine of equivalents considered by the jury. The Court thereafter deleted the instruction on equivalents and instructed the jury only on literal infringement. App. A10.

The special interrogatories submitted to the jury included one directed to the question of infringement. The accompanying instruction required the jury to find in-

fringement only if it found direct or literal infringement without consideration being given to the doctrine of equivalents. App. A26. So instructed, the jury returned its answers to the special interrogatories, finding Nestier's patent not infringed. The Trial Court entered judgment on the jury's finding of noninfringement. App. A19.

The Court of Appeals for the Federal Circuit affirmed the Trial Court on its finding of noninfringement. The Court of Appeals decided that the doctrine of equivalents need not be addressed in this case. Also finding itself in the face of its own precedent holding that the doctrine of equivalents must be applied in every case,[1] the Court distinguished this case stating that it was a jury trial—not a bench trial. The Court concluded that only in the latter instance is there a right to have the doctrine of equivalents considered.[2] The Court of Appeals denied Nestier's petition for a rehearing and declined its suggestion for Rehearing *En Banc*. The petition alleged that the Court's rulings were contrary to established Supreme Court precedent and drew unconstitutional penalties to litigants who had demanded their right to a trial by jury.

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1. *Decca Limited v. United States*, 420 F.2d 1010, 1014 (Ct. Cl. 1970). (The Federal Circuit has adopted, as precedent, the opinions of its predecessor courts, the Court of Claims and the Court of Customs and Patent Appeals. *South Corp. v. United States*, 690 F.2d 1368 (Fed. Cir. 1982)).

2. "Moreover, the theory of infringement through equivalence is not inherent, or necessarily included, in literal infringement theory when that alone is presented to a jury, although the circumstances and requirements might possibly differ in a non-jury trial." Opinion at p. 6 (App. A5).

## REASONS FOR GRANTING THE WRIT

With the passage of the Federal Courts Improvement Act under 28 U.S.C. § 1295 exclusive appellate jurisdiction in patent cases was relegated to the Court of Appeals for the Federal Circuit. The unification of appellate jurisdiction in patent cases was well received by the patent bar as it was felt that uniform interpretation of the Patent Laws would be achieved. With all its advantages, an inherent disadvantage to implementation of a sole appellate body in patent cases arises when that Court seeks to establish by itself rulings which run afoul to precedent that had heretofore been well established both by the Supreme Court and the lower courts.[3] The Supreme Court, however, still remains the ultimate arbiter on questions of patent law, as it maintains its appellate jurisdiction over the CAFC. The rulings of the courts below, both in this case, and the course of cases heretofore, show a trend in the CAFC to detract from this Court's established doctrine of equivalents in patent cases, and an impingement on the right to trial by a jury.

The Supreme Court is the only means, other than congressional action, by which the actions and trends of the CAFC may be checked and rectified to be realigned in the path established by this Court. It is for this reason that Nestier pursues this course in seeking the grant of a writ of certiorari in the present decision.

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3. The issues presented herein are by no means unique to Nestier. The problem is a recurring one. The CAFC's cutback on the *Graver Tank* definition of infringement was presented to this court recently in *McGill Incorporated v. John Zink Company*, Case No. 84-546 (1984). In that case, this Court chose, in its discretion, to leave the CAFC decision to stand.

## I. THE DEFINITION OF PATENT INFRINGEMENT INCLUDES CONSIDERATION OF THE SUBSTITUTION OF EQUIVALENTS TO CLAIMED ELEMENTS

Article I, § 8, cl. 8 of the United States Constitution gives to Congress the Power:

> To promote the Progress of Science and useful Arts, by securing for limited Times, to Authors, and Inventors the exclusive Right to their respective Writings, and Discoveries.

U.S. Const. art. I, § 8, cl. 8. Therein, the framers of the Constitution contemplated a barter system by which technological advancements would be stimulated by granting limited rights to inventors in exchange for disclosures of their inventions to the public at large. Pursuant to this power, Congress enacted the patent statutes. The patent document itself contains a written specification wherein the invention is described to the public by the inventor.

> The specification shall contain a written description of the invention, and of the manner of process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which is pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 112 (1984). The metes and bounds of the protection granted to an inventor by Congress in exchange for this disclosure, are dictated by the claims of the invention.

> The specification shall conclude with one or more claims particularly pointing out and distinctly claim-

> ing the subject matter which the applicant regards as his invention.

*Id.* Infringement of the patent is defined by Congress as:

> whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

35 U.S.C. § 271 (1984). This definition makes no mention of the claims of Section 112, and leaves substantial room for judicial interpretation.

To be considered a "direct" infringer of a patent, it is settled that each and every element of a claim must be present in a defendant's product. Thus, for example, if the patent claim recites a system which includes an air operated butterfly valve, the accused system must include such a valve in order for there to be literal or direct infringement. For well over 100 years, however, it has been apparent that:

> One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy.

*Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U.S. 605, 607 (1950). It is for this reason that this Court interprets 35 U.S.C. § 271 as encompassing not only the literal elements defined with the claim of a patent, but also the equivalents therefor:

> To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system.

*Id.*

Thus, using the example above, a case for infringement may be made out if the accused system utilizes an air operated gate valve in lieu of an air operated butterfly valve—a gate valve being the full mechanical equivalent of a butterfly valve.

> a patentee may invoke this doctrine to "proceed against the producer of a device if it performs substantially the same function in substantially the same way to obtain the same result."

*Id.* at 608 (quoting *Sanitary Refrigerator Co. v. Winters* 280 U.S. 30, 42 (1929)).

## II. THE LOWER COURTS DEPRIVED NESTIER OF ITS RIGHT TO HAVE ALL FACTUAL ISSUES TRIED TO A JURY

When the owner of a patent seeks remedy for an alleged infringement, the question of infringement is one of fact. *Winans v. Denmead,* 56 U.S. 330, 338 (1854). The Constitution secures to civil litigants the right to have all factual questions tried to a jury:

> In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law.

U.S. Const. amend. VII. As with any finding of infringement, "A finding of equivalence is a determination of fact." *Graver Tank,* 339 U.S. at 609.

Findings of equivalents need not be based on any particular form of evidence.

> Proof can be made in any form: through testimony of experts or others versed in the technology; by documents, including text and treatises; and, of course, by the disclosures of the prior art. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of the evidence.

*Id.* Notwithstanding this precedent, the CAFC concluded that equivalents need not be addressed in this case in that a particular form of evidence was not present. The Court of Appeals held:

> At no time did Nestier's attorneys or witness present evidence which was explicitly related to the jury in the *Graver Tank* terms of equivalence of functions, means and result.

Opinion at 5-6 (App. A5). This Court, however, has expressly pointed out that such testimony on equivalents is unnecessary, "Argument to show that the form of [the products] are substantially the same is quite unnecessary, as it is proved to a demonstration by a comparison of the two devices." *Machine Co. v. Murphy,* 97 U.S. 120, 124 (1877).

Petitioner conducted numerous demonstrations at trial to show the interchangeability of Petitioner's and Respondent's tote boxes. Petitioner presented evidence that showed that Respondent's tote boxes were, in fact, designed to nest with and to stack with Petitioner's tote boxes. The theory of Petitioner's case was that there was infringement. Petitioner requested the Court to instruct the jury as to infringement based on the two-part test set out in *Graver Tank*:

> If accused matter falls clearly within the claim, infringement is made out and that is the end of it.

> But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of the law.

*Id.* 339 U.S. at 607.

Not desiring to plead inconsistent theories to the jury, Petitioner presented a case of direct literal infringement. In doing so, however, Petitioner expected, and indeed requested the Court to instruct the jury, that if it did not find direct or literal infringement that it could, nonetheless, still find infringement if it found equivalent elements to be used in the accused tote box. Indeed, Petitioner requested the Court and expected an instruction that the Doctrine of Equivalents was to be examined if direct literal infringement was not found so:

> that one may not practice a fraud on a patent.

*Id.* at 608.

Because Petitioner's expert witness advocated a case of direct or literal infringement without application of the Doctrine of Equivalents, the trial court refused to instruct the jury on the Doctrine of Equivalents. The CAFC concluded that the jury need not have been instructed on the application of the Doctrine of Equivalents.

The opinion of the CAFC thus requires the patentee to either argue to a jury inconsistent positions of infringement based on direct or literal infringement and infringe-

ment by virtue of the application of the Doctrine of Equivalents or, alternately, to argue one *or* the other.

In bench trials it is recognized, however, that no theory as to the form of infringement need be argued as the application of the Doctrine of Equivalents must, *in every case,* be made. *Decca Limited,* 420 F.2d at 1014.

The CAFC in its opinion below (App. A5-A6) recognizes the necessity of applying the Doctrine of Equivalents in bench trials but states that such application may not be made in jury trials where, as here, a case of direct literal infringement is advocated. Opinion at p. 6 (App. A5-A6).

If, therefore, a determination of infringement based on the two-part test of *Graver Tank* is the law of the land and, if, the CAFC holds that a trial judge must, in every case, apply the Doctrine of Equivalents where direct literal infringement is not found, how can there be any different result in a patent infringement case tried to a jury? The Constitution guarantees that all factual questions may be decided by a jury:

> The plaintiff in error complains that he was entitled to have the evidence submitted to the jury, and the benefit of such conclusions of fact as it might justifiably have drawn; a right he demanded and did not waive; and that he has been deprived of it, by the act of the court, in entering a judgment against him on its own view of the evidence, without the intervention of a jury. In this particular, we think error has been well assigned.

*Baylis v. Travelers' Ins. Co. of Hartford, Conn.,* 113 U.S. 316 (1885). The Courts below did not conclude that a directed verdict could or should have been granted, but only that the issue of infringement by equivalents did not have to be presented to the jury. For this reason, the conclusion of the lower Courts cannot be permitted to stand.

## CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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# APPENDIX

## OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

(Decided August 1, 1984)

Appeal No. 83-1313

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

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NESTIER CORPORATION,
*Appellant,*

v.

MENASHA CORPORATION - LEWISYSTEMS DIVISION,
*Appellee.*

---

Before MARKEY, *Chief Judge,* FRIEDMAN, RICH, DAVIS and BALDWIN, *Circuit Judges.*

DAVIS, *Circuit Judge.*

Nestier Corporation (Nestier or appellant) appeals the judgment of the United States District Court for the Southern District of Ohio, entered April 2, 1983, finding non-infringement of U.S. Patent No. 3,463,345 (the '345 patent)[1] by the Menasha Corporation, LEWISystems Division (Menasha or appellee). We affirm.

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1. The '345 patent was issued August 26, 1969 on an application filed August 28, 1968 The inventor was Kenneth R. Bockenstette.

I

The '345 patent is directed to a reusable tote box, with an attached lid, molded from plastic, for storing and transporting merchandise and various articles. The tote boxes are capable [2] of nesting, *i.e.*, with lids open one box may be placed inside another. With lids or covers closed, the boxes may also be stacked, one on top of another. The lids of Nestier's boxes have a flat surface and an inset feature which prevents one box from sliding off of the other when stacked together. The boxes furthermore have complementary interfitting raised and depressed areas in the free edges of the covers to enhance security as well as to provide cover strength for stacking.

Appellee Menasha produces attached lid tote boxes which are dimensionally compatible with Nestier's boxes, *i.e.*, they can be nested in or stacked upon Nestier's boxes. The designs of Nestier's and Menasha's respective tote box covers are different. Menasha's boxes have neither inset covers nor a plurality of interdigitating teeth on each cover.

On July 2, 1981, Nestier sued Menasha, charging that various tote boxes manufactured, distributed, and sold by Menasha willfully infringed the '345 patent. In defense, Menasha denied infringement, claimed that the '345 patent was invalid on several grounds, and later added the claim that Nestier lacked title to the patent. A thirteen day jury trial was conducted in late July and early August, 1983. As ordered by the District Court, counsel for both parties filed requested jury instructions on the opening day of the trial. Judge Rice finalized the jury instructions near the trial's conclusion by adopting, modifying, or rejecting various portions of the [3] proposed instructions. Not included were jury instructions (requested by appellant) concerning evaluation of infringement under the doctrine of equivalents.

The jury was instructed and given six special interrogatories related to issues of (1) infringement, (2) willful infringement, (3) invalidity based on (a) obviousness, (b) vagueness and indefiniteness, and/or (c) failure to disclose best mode, and (4) damages. The jury found that there had been no infringement of the patent by Menasha, and that the patent was not invalid for obviousness of the invention claimed nor was the patent invalid for vagueness or failure to disclose best mode. The jury did not answer the damages interrogatory because it found no infringement. Nestier made no motion for a judgment notwithstanding the verdict, nor did it request a new trial.

The District Court then entered judgment in favor of Menasha holding the '345 patent not infringed. No judgment was entered on the issue of validity/non-validity[2] or on other issues raised by the parties that had not been previously **[4]** disposed of by motion.[3] On ap-

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2. The District Court stated in the entry regarding judgment that:

> [O]nce non-infringement is found, it would be improper to enter judgment on validity. *Deposit Guaranty National Bank v. Roper*, 445 U.S. 326, 334-35 at n.7 (1980). Accordingly, this court will only enter judgment on the issue of validity/non-validity (and on other issues requested by the parties) when and if this court, or an appellate court, determines that the judgment regarding non-infringement must be overturned . . . .

3. Nestier moved for a directed verdict at the close of Menasha's case on the issues of title, infringement, willful infringement, validity, notice of infringement (for purposes of pre-suit damages), and Nestier's status as sole party in interest. The court took under advisement the motions based on title and on party in interest, and subsequently ruled in Nestier's favor on those issues at the close of the evidence; all other motions were denied. At the close of all the evidence, Nestier did not move for a directed verdict. Menasha's motions at that time were all denied, including motions for directed verdict for failure to prove title, failure to join an indispensible party, patent invalidity for obviousness, non-infringement and non-willfulness, failure to prove patent marking or notice of infringement for pre-suit damages, and failure to prove by competent evidence an amount of damages post-suit.

peal, Nestier asserts that the District Court erred in (1) not instructing the jury on the doctrine of equivalents in its charges relating to infringement and willful infringement, (2) not directing a verdict in Nestier's favor determining willful infringement and that Menasha did not meet its burden of proof as to patent invalidity, and (3) not making a holding in its entry of judgment that Menasha did not meet its burden of proof relative to its defense of patent invalidity.

## II

The doctrine of equivalence permits a finding of infringement, despite the absence of a literal identity between a claimed device and the elements of an alleged infringing device, where the "two devices do the same work in substantially the same way, and accomplish substantially the same result." *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 339 U.S. 605, 608 (1950), *quoting Machine Co. v. Murphy*, **[5]** 97 U.S. 120, 125 (1877). Equivalence in this regard "does not require complete identity for every purpose and in every respect." *Graver Tank*, 339 U.S. at 609. Our review of the record and arguments on appeal reveals no error or abuse of discretion by the District Court in failing to include an instruction to the jury concerning infringement under the doctrine of equivalence. Simply stated, there was no basis in the evidence such that the court was required to give the jury any such instruction, and appellant did not urge (at the trial) infringement on the basis of equivalents.

Appellant maintains nevertheless that (1) there was sufficient evidence to require an instruction on equivalence, and that (2) in any event, analysis of infringement under the doctrine of equivalence necessarily follows any analysis of liternal infringement in which no literal infringement is found. As we have noted, we disagree on both points.

At trial, appellant presented the position, through testimony and demonstration, that the Menasha tote boxes were compatible with Nestier's boxes in both their nesting and stacking functions. Appellant also introduced documentary evidence to indicate that Menasha intended to produce boxes which were compatible with Nestier's boxes. However, this evidence was presented as part of appellant's claims of literal, willful infringement. At no time did Nestier's attorneys or witnesses present evidence which was explicitly **[6]** related to the jury in the *Graver Tank* terms of equivalence of functions, means, and result. Analysis of equivalence involves those three factors, and a jury cannot be expected to be able to make any such determination absent evidence and argument concerning the doctrine and each of its elements. Furthermore, equivalence must be established with respect to the claims of the patent, not (as was perhaps attempted here) for the commercial structures involved. "[I]t is not enough merely to demonstrate the equivalency of two commercial devices." *Tektronix, Inc. v. United States*, 179 USPQ 703, 704 (Ct. Cl. 1973).[4] This is not to say that the exact *Graver Tank* language must be used by attorneys and witnesses. However, appellant, which bore the burden of proving infringement, had the responsibility of establishing that context at trial and of stating its case within that context—but it failed to do so.

Moreover, the theory of infringement through equivalence is not inherent, or necessarily included, in literal infringement theory when that alone is presented to a jury, although the circumstances and requirements might possibly differ in a non-jury trial. For a bench trial,

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4. The evidence cited by appellant at the oral argument as specifically bearing on the doctrine of equivalents all relates to the commercial structures of both parties, not to the claims of the '345 patent.

*see, e.g., Decca Limited v. United States,* 420 F.2d 1010, 1014, 164 USPQ 348, 351 (Ct. Cl. 1970). In a jury trial, a court should not instruct on a [7] proposition of law about which there is no competent evidence. *Jackson v. Southern Railway Co.,* 317 F.2d 532, 537 (5th Cir.), *cert. denied,* 375 U.S. 837 (1963). Competent proof is needed, not mere "conjecture and speculation." *General Motors Corp. v. Walden,* 406 F.2d 606, 609 (10th Cir. 1969). The fact that some of Nestier's arguments concerning literal infringement might also have been relevant to an equivalency analysis is not sufficient, in itself, to establish that evidence and context for a jury. Although evidence was presented here which—had the context been established—might have been related to equivalence of functions and results, there was an absence of any such evidence concerning equivalence of means.

Indeed, two trial events lend especially telling support for the district judge's decision not to include any equivalence instruction. At trial, Nestier's own expert witness Mr. Beall refused to give an opinion on equivalence when questioned by Nestier's counsel:

> Q. With respect to the matter of equivalence, do you have an opinion as to whether there is equivalence between the Menasha box and the structure claimed in the Bockenstette claims?
>
> [Objection asserted and denied.]
>
> MR. BEALL: I would never get to the Doctrine of Equivalence because I—I think the claim describes the Menasha box so I would never consider equivalence but I—I don't think that was your—I would not then have an opinion because I don't think the Doctrine of Equivalence comes into play.
>
> MR. FAGAN (Nestier's attorney): All right. Thank you, Mr. Beall.

By Mr. Fagan:

[8] Q. Mr. Beall, were you—

A. I have an example of the Doctrine of Equivalence that I just thought of sitting here if that would help any.

Q. I think that might be just past the subject of the question.

In addition, Nestier's counsel stated, during the conference (after the evidence) on the form of jury instructions, that the doctrine of equivalents was not Nestier's theory:

Mr. Fagan: I can't dispute that. It is not our theory. We have from the very beginning advocated direct literal infringement.

That Mr. Beall had no opinion on equivalence, and, that Nestier's counsel stated that equivalence was not Nestier's theory, do not *per se* mean that the question of equivalence could have played no role in this case. However, those statements, taken in conjunction with the lack of evidence in the rest of the record to form a basis for analysis of equivalence by the jury, provide ample support for Judge Rice's decision not to include any instruction to the jury which would have required analysis of that kind of infringement.[5]

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5. Nestier also claims error by the District Court in not instructing the jury on equivalence with regard to willful infringement. Because, and we hold, there was no occasion to give an instruction on equivalence with respect to literal infringement, there was equally no need to give one with respect to willful infringement. In any event, Nestier apparently requested no such instruction with respect to willfulness, nor is there any evidentiary basis in the record for one.

[9] III

Likewise without merit are Nestier's other arguments claiming error by the district judge concerning patent invalidity and willful infringement. First, Nestier failed to move for directed verdict on patent validity and willful infringement at the close of all the evidence, and cannot now claim error for the court's failure to direct a verdict on those issues. Nestier had moved for a directed verdict at the end of appellee's case, but introduction of new evidence on rebuttal, after the motion was denied, waived any possible error in the denial, absent renewal of the motion at the close of the evidence. *See* 5A Moore, Federal Practice ¶ 50.05[1]; *see also Gephardt v. Wilson Freight Forwarding Co.*, 348 F.2d 129, 132 (3d Cir. 1965.[6] In addition, appellant made no motion, after the verdict, for judgment notwithstanding the verdict or for new trial. Appellant seems to maintain that such motions were not necessary in order to preserve the rights we discuss in this Part III. It is settled that this position is incorrect. *See, e.g., Railroad Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506, 1510-12 (Fed. Cir. 1984).

IV

Finally, there was no reversible error or abuse of discretion, in the circumstances here, in the District Court's [10] withholding of judgment on the issues related to the '345 patent's validity—despite the jury's having found the patent not invalid—in light of the jury's finding of noninfringement. As stated by one of our predecessor courts,

> While the better practice is to treat both the validity and infringement issues, *Sinclair Co. v. Interchemical*

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6. A motion for directed verdict at that time would have been required in order to have moved for judgment notwithstanding the verdict, under Fed. R. Civ. P. 50(b).

*Corp.*, 325 U.S. 327, 65 S. Ct. 1143, 89 L. Ed. 1644 (1945) particularly in view of the public interest in the validity issue, *Ditto, Inc. v. Minnesota Mining and Manufacturing,* 336 F.2d 67 (9th Cir. 1964), it is not always necessary to do so. *Dresser Industries, Inc. v. United States,* 432 F.2d 787, 193 Ct. Cl. 140 (1970). Where, as here, non-infringement is clear and invalidity is not plainly evident, it is appropriate to treat only the infringement issue. *Lockwood v. Langerdorf United Bakeries,* 324 F.2d 82 (9th Cir. 1963).

*Leesona Corp. v. United States,* 530 F.2d 896, 906, n.9, 192 USPQ 672 (Ct. Cl. 1976), *cert. denied,* 444 U.S. 991 (1979).

There is a stronger public interest in the elimination of invalid patents than in the affirmation of a patent as valid, at least in part because patents maintain a presumption of validity. *See Hieger v. Ford Motor Co.*, 516 F.2d 1324, 1327, 186 USPQ 374, 375 (6th Cir. 1975), *cert. denied,* 423 U.S. 1056 (1976). Here, the '345 patent was judged to have been not infringed by Menasha; to then adjudge the patent valid would be to decide an unnecessary question as between these parties. *Deposit Guaranty National Bank v. Roper,* 445 U.S. 326, 333-34, *reh. denied,* 446 U.S. 947 (1980). Menasha does not ask us to pass on validity.

*Conclusion*

For these reasons, the judgment of the District Court is affirmed.

*AFFIRMED.*

**DISTRICT COURT'S DISPOSITION OF PLAINTIFF'S AND DEFENDANT'S REQUESTED JURY INSTRUCTIONS**

(Filed March 22, 1983)

Case No. C-3-81-359

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF OHIO
WESTERN DIVISION

NESTIER CORPORATION,
*Plaintiff,*

vs.

MENASHA CORPORATION,
LEWISYSTEMS DIVISION,
*Defendant.*

DISPOSITION OF PLAINTIFF'S AND DEFENDANT'S REQUESTED JURY INSTRUCTIONS

*Plaintiff's Requested Instructions*

| Title of Proposed Instruction | Page No. | Disposition |
|---|---|---|
| Introduction | 1 | adopted |
| Function of the Jury | 2 | adopted |
| Instructions Apply to Each Party | 3 | adopted |
| Corporations are Persons Before the Law | 4 | adopted |
| Evidence | 5 | adopted |
| Direct and Circumstantial Evidence | 6 | adopted |

| Title of Proposed Instruction | Page No. | Disposition |
|---|---|---|
| Credibility of Witnesses | 7–8 | adopted |
| Expert Witness | 9 | adopted (as modified) |
| Depositions | 10 | adopted |
| A Patent is Enforceable by Court Action | 11 | not used |
| The Patent in Suit | 12 | adopted (as modified) |
| The Parties and Their Claims | 13–14 | adopted (as modified) |
| Uncontroverted Facts | 15–17 | adopted (as modified) |
| Issues of Fact to be Resolved | 18–20 | not used |
| Conditions of Patentability | 21 | adopted (as modified) |
| Infringement | 22–25 | adopted (as modified) |
| Willful or Wanton Infringement | 26–27 | adopted (as modified) |
| Functions of Patent Claims | 28 | adopted |
| Independent and Dependent Claims | 29 | adopted |
| Claims of Patent No. 3,463,345 | 30–31 | adopted |
| Burden of Proof for Infringement | 32 | adopted (as modified) |

| Title of Proposed Instruction | Page No. | Disposition |
|---|---|---|
| Defendant's Claims | 33 | adopted (as modified) |
| Presumptions - Generally | 34 | adopted (as modified) |
| Presumption of Validity | 35–38 | adopted (as modified) |
| Definition of Prior Art | 39 | not used |
| Obviousness | 40–47 | adopted (as modified) |
| Burden of Proof Regarding Unobviousness | 48 | adopted (as modified) |
| Best Mode Defense | 49 | adopted (as modified) |
| Burden of Proof Regarding Best Mode | 50 | adopted |
| Damages in General | 51 | adopted (as modified) |
| The Amount of Damages | 52 | adopted (as modified) |
| Special Damages | 53 | not used |
| Burden of Proof - Generally | 54–55 | adopted (as modified) |
| Preponderance of the Evidence | 56 | adopted |
| Clear and Convincing Evidence | 57 | not used |

| Title of Proposed Instruction | Page No. | Disposition |
|---|---|---|
| Certainty Not Required | 58 | adopted |
| Special Interrogatories | 59–60 | adopted (as modified) |
| No Recommended Verdict | 61 | adopted (as modified) |
| Duty in Deliberating | 62 | adopted (as modified) |
| Miscellaneous | 63 | adopted (as modified) |
| Vagueness Defense | 64–65 | not used |

*Defendant's Requested Instructions*

| Title of Proposed Instruction | No. | Disposition |
|---|---|---|
| Province of the Court and Jury | 1 | adopted |
| Province of Jury | 2 | adopted |
| The Evidence | 3 | adopted |
| Credibility of Witnesses | 4 | adopted |
| Expert witness | 5 | adopted |
| Depositions as Evidence | 6 | adopted |
| Stipulations, Not Arguments of Counsel, Are Facts | 7 | adopted |
| The Parties and Their Contentions | 8 | adopted (as modified) |
| Purpose of a Patent | 9 | not used |

| Title of Proposed Instruction | No. | Disposition |
|---|---|---|
| Burdens of Proof | 10 | adopted (as modified) |
| Burden of Proof in Patent Cases | 11 | adopted (as modified) |
| The Requirement of Title | 12 | not used |
| Infringement | 13 | adopted (as modified) |
| Claim Interpretation | 14 | adopted (as modified) |
| Specific Interpretation of Claim 1 ("interfitting") | 15 | not used |
| Specific Interpretation of Claim 1 ("interfitting") | 15 (alt.) | adopted |
| Range of Equivalents | 16 | not used |
| Specific Interpretation of Claim 1 ("inset") | 16 (alt.) | adopted (as modified) |
| Range of Equivalents | 16 (alt.) | not used |
| Infringement - Burden of Proof | 17 | adopted (as modified) |
| Damages - Burden of Proof | 18 | adopted (as modified) |
| No Marking and No Notice | 19 | adopted (as modified) |
| Damages - Reasonable Royalty | 20 | not used |
| Willful Infringement | 21 | adopted (as modified) |

| Title of Proposed Instruction | No. | Disposition |
|---|---|---|
| The Requirement of Nonobviousness | 22 | adopted (as modified) |
| The Manner of Deciding the Obviousness Issue | 23 | adopted (as modified) |
| Issuance of the Patent | 24 | not used |
| Meaning of Prior Art | 25 | adopted (as modified) |
| The Ordinary Person in the Art | 26 | adopted (as modified) |
| Considerations for the Obviousness Issue | 27 | adopted (as modified) |
| Claims Reciting Combinations of Old Elements | 28 | adopted (as modified) |
| The Necessity of an Unexpected Result | 29 | adopted (as modified) |
| Substitution of an Old Element | 30 | adopted |
| Secondary Considerations | 31 | not used |
| Copying | 32 | not used |
| Copying as Evidence of Obviousness | 33 | adopted (as modified) |
| Duty of Independent Decision | 34 | not used |
| Noninfringement if Defendant Practices the Prior Art | 35 | adopted (as modified) |

| Title of Proposed Instruction | No. | Disposition |
|---|---|---|
| Patent Invalidity | 36 | adopted (as modified) |
| The Requirement of Best Mode | 37 | adopted (as modified) |
| The Requirement of Specificity | 38 | adopted (as modified) |
| Unjust and Vexatious Litigation | 39 | not used (withdrawn) |
| Communications Between Court and Jury During Jury's Deliberations | 40 | adopted (as modified) |
| Conclusion | 41 | adopted (as modified) |

/s/ WALTER H. RICE
*United States District Judge*

Copies given to:

Christopher Fagan, Attorney at Law
Pat Roach, Attorney at Law
Wayne Babler, Attorney at Law

## DISTRICT COURT'S ENTRY REGARDING JUDGMENT

(Filed August 1, 1983)

Case No. C-3-81-359

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF OHIO
WESTERN DIVISION

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NESTIER CORPORATION,
*Plaintiff,*

vs.

MENASHA CORPORATION, LEWISYSTEMS DIVISION,
*Defendant.*

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ENTRY REGARDING JUDGMENT

This action was tried before a jury, regarding the infringement and validity of U.S. Letters Patent No. 3,463,345. The jury returned answers to questions, finding that Defendant had not infringed the patent, but also finding that the patent was valid.

Based on the foregoing findings by the jury, the Court will order that judgment be entered on behalf of the Defendant on the infringement question. The question of validity is ultimately one of law for the Court to determine, although the jury's findings can aid in that determination. *Graham v. John Deere*, 383 U.S. 1, 17 (1966). However, once non-infringement is found, it would be improper to enter judgment on validity. *Deposit Guaranty*

*National Bank v. Roper*, 445 U.S. 326, 334-35 & n.7 (1980). Accordingly, this Court will only enter judgment on the issue of validity/non-validity (and on other issues requested by the parties) when and if this Court, or an appellate court, determines that the judgment regarding non-infringement must be overturned, and then only after giving both parties the opportunity to supplement the jury's non-binding findings with suggested findings of fact and conclusions of law of their own on the issue of validity/non-validity.

The Clerk is ordered to enter judgment in this case in conformity with the foregoing, to wit: judgment is to be entered for Defendant, in that Defendant did not infringe the patent in suit. No judgment will be entered, at this time, on the question of validity and on other issues.

/s/ WALTER H. RICE
*United States District Judge*

# JUDGMENT ENTRY OF THE DISTRICT COURT

(Dated August 2, 1983)

No. C-3-81-359

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF OHIO

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NESTIER CORPORATION,
*Plaintiff,*

v.

MENASHA CORPORATION, LEWISYSTEMS DIVISION,
*Defendant.*

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[X] JURY VERDICT. This action came before the Court and a jury with the judicial officer named above presiding. The issues have been tried and the jury has rendered its verdict.

IT IS ORDERED AND ADJUDGED

That, the jury having found for the Defendant on the question of infringement, judgment is hereby entered for the Defendant and against the Plaintiff, in that Defendant did not infringe the patent in suit. No judgment is entered at this time on the question of validity and other issues.

## JUDGMENT ENTRY OF THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT

(Dated August 1, 1984)

No. 83-1313

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

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NESTIER CORPORATION,
*Appellant,*

v.

MENASHA CORPORATION-LEWISYSTEMS DIVISION,
*Appellee.*

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JUDGMENT

ON APPEAL from the U.S. District Court for the Southern District of Ohio (West. Div.)

This CAUSE having been heard and considered, it is ORDERED and ADJUDGED: AFFIRMED.

ENTERED BY ORDER OF THE COURT

/s/ GEORGE E. HUTCHINSON
*Clerk*

DATED August 1, 1984
Appellant's Petition for
Rehearing, Denied,
October 17, 1984, and
Suggestion for Rehearing
In Banc, Declined,
October 17, 1984.

## ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING PETITION FOR REHEARING AND SUGGESTION FOR REHEARING IN BANC

(Dated October 17, 1984)

No. 83-1313

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

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NESTIER CORPORATION,
*Appellant,*

v.

MENASHA CORPORATION-LEWISYSTEMS DIVISION,
*Appellee.*

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ORDER

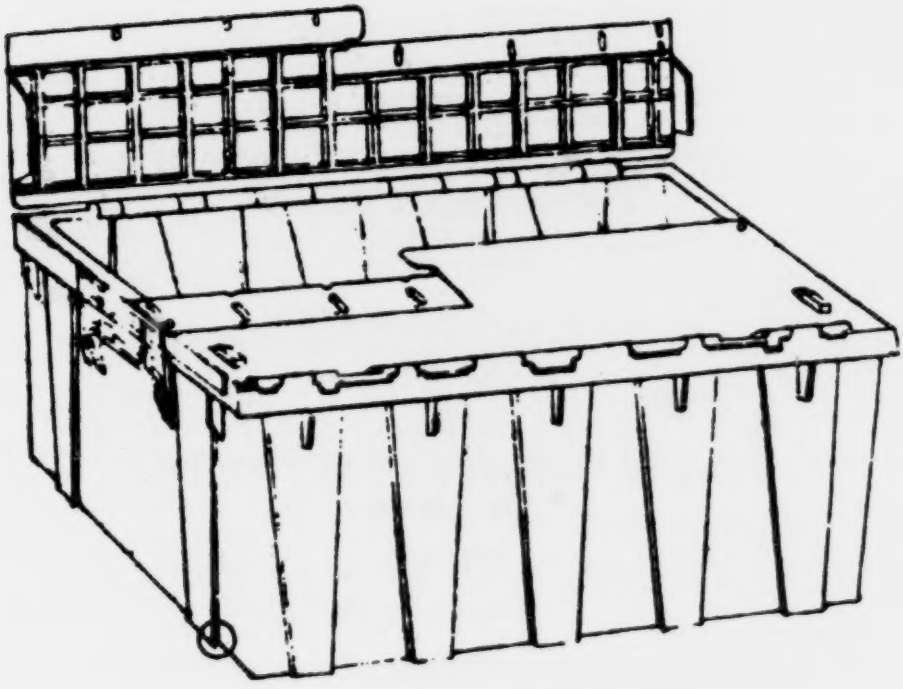
A petition for rehearing and a suggestion for rehearing in banc having been filed in this case,

UPON CONSIDERATION THEREOF, it is Ordered by the court that the petition for rehearing be, and the same is hereby, Denied.

The suggestion for rehearing in banc is declined.

FOR THE COURT

/s/ GEORGE E. HUTCHINSON
*Clerk*



ACCUSED FLIP-PAK 14 TOTE BOX

Physical Exhibit
Representation of Tote Box Shown Above

# PLAINTIFF'S PROPOSED JURY INSTRUCTIONS FILED IN THE DISTRICT COURT

Case No. C-3-81-359

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NESTIER CORPORATION

v.

MENASHA CORPORATION

* * * * *

Plaintiff's Proposed Instruction No. .....

## INFRINGEMENT

The first issue which you must consider relates to whether or not Defendant has infringed the Bockenstette patent. Since the law presumes the Bockenstette patent to be valid,[1] Nestier does not have to prove the validity of the patent, but does have to prove, by a preponderance or the greater weight of the evidence, that the Bockenstette patent has been infringed.

By definition, infringement occurs when someone, without authority or license, or other permission from the owner of the patent, makes or uses or sells the patented invention anywhere in the United States during the term of the patent.[2] Infringement does not require copying, but if you find copying to have occurred you should consider such fact in your determination of whether or not Menasha has infringed. Further, it does not matter whether or not Menasha intended to infringe the patent, or in good faith did not believe its acts constituted in-

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1. 35 U.S.C. § 282.
2. 35 U.S.C. § 271.

fringement.[3] However, if you find that Menasha knew that it would infringe the patent and proceeded to do so willfully and deliberately, you should also consider this fact in your determination of whether Defendant has infringed the Bockenstette patent.[4]

In determining whether a patent is infringed, resort must be had in the first instance to the words of the claims. If the accused device, in this case Menasha's Flipak 14, Flipak 15 and Flipak 24 containers, falls within the literal language of one or more of the claims of the Bockensette patent, infringement is made out and that is the end of it.[5] In determining whether such literal infringement exists you should apply reasonable and usual definitions to all the words of the claims. If an ambiguity exists in the language of the claim, resort may be had to the specification and drawings to interpret the meaning of the language.[6]

But the Supreme Court of the United States has also recognized that to permit substantial imitation of a patented invention which does not copy every literal detail set forth in the claims would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent, though adding nothing. In re-

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3. 3 E. Devitt and C. Blackmar, *Federal Jury Practice and Instructions* at 402 (3rd Edition 1977). (Hereinafter "F.J.P.I.").

4. *Coleman Company v. Holly Manufacturing Company*, 269 F.2d 660 (9th Cir., 1959); *American Safety Table Company v. Schreiber*, 415 F.2d 373 (2d Cir. 1969), *cert. denied*, 396 U.S. 1038 (1970).

5. *Graver Tank & Mfg. Co. v. Linde Air Prod. Co.*, 339 U.S. 605, 607 (1950).

6. See *Kolene Corporation v. Motor City Metal Treating, Inc.*, 307 F. Supp. 1251, 1259 (E.D. Mich. 1969), *aff'd*, 440 F.2d 77 (6th Cir. 1971), *cert. denied*, 404 U.S. 886 (1971); *Arnold Pipe Rentals Co. v. Engineering Enterprises, Inc.*, 350 F.2d 885 (5th Cir. 1965).

sponse to this the courts have formulated a doctrine known as the "Doctrine of Equivalents." The heart of this doctrine is that one may not practice a fraud on the patent. Thus, if the accused method performs substantially the same function in substantially the same way to obtain substantially the same result as that set forth in the claims, it is, under this Doctrine of Equivalents, the same, and as such constitutes an infringement of that claim.[7] In addition, infringement is not avoided merely because the accused device is not manufactured as well as the inventor intended the patented device to be manufactured.[8]

Every patent, even those for improvement inventions, have some range of equivalents to which they are entitled. An inventor is entitled to a reasonable scope of protection for his invention. Infringement exists here, regardless of modification, if the essence of the Bockenstette invention remains in the accused Flipak 14, Flipak 15 and Flipak 24 containers.[9]

Therefore, infringement is made out if the accused Flipak 14, Flipak 15 and Flipak 24 containers fall within the literal language of one or more of the claims of the Bockenstette patent or if the accused containers perform substantially the same function, in substantially the same way to obtain substantially the same result as the Bockenstette invention of United States Letters Patent No. 3,463,345. If you find either to be so, then you should find

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7. *Graver Tank & Mfg. Co. v. Linde Air Prod. Co., supra,* at 607, 609. See also *Sanitary Refrigerator Co. v. Winters,* 280 U.S. 30 (1929); *Marvel Specialty Company v. Bell Hosiery Hills, Inc.,* 330 F.2d 164, 174-175 (4th Cir. 1964), *cert. denied,* 379 U.S. 899 (1964).

8. *Machinenfabrik Rieter A.G. v. Greenwood Mills,* 340 F Supp. 1103 (D.S.C. 1972).

9. *Eastern Rotorcraft Corporation v. United States,* 397 F.2d 978, 982 (Ct. Cl. 1968).

for the Plaintiff as to Special Interrogatory No. 1 and answer it "Yes." Otherwise, you should answer Special Interrogatory No. 1 "No."[10]

## EXCERPT FROM TRIAL TRANSCRIPT

### Infringement Instruction

[3] The Court: You must consider whether or not Defendant has infringed the Bockenstette patent. Nestier must prove, by a preponderance or the greater weight of the evidence, that the Bockenstette patent has been infringed.

By definition, infringement occurs when someone, without authority or license, or other permission from the owner of the patent, makes or uses or sells the patented invention anywhere in the United States during the term of the patent. Infringement does not require intentional copying of the invention, but if you find such copying to have occurred you should consider such fact, along with all the facts and circumstances in evidence, in your determination of whether or not Menasha has infringed. Further, it does not matter whether or not Menasha intended to infringe the patent, or in good faith did not believe its acts constituted infringement. However, if you find that Menasha knew that it would infringe the patent and proceeded to do so willfully and deliberately, you should also consider this fact, along with all the facts and circumstances in evidence, in your determination of whether Defendant has infringed the Bockenstette patent.

[4] In determining whether a patent is infringed, resort must be had in the first instance to the words

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10. Entire instruction modeled after instruction in *Ragan* case.

of the claims. If the accused device, in this case Menasha's Flipak 14, Flipak 15 and Flipak 24 containers, falls within the literal language of one or more of the claims of the Bockenstette patent, infringement is made out and that is the end of it. In determining whether such literal infringement exists you should apply reasonable and usual definitions to all the words of the claims, unless it appears that the inventor used them differently.

The patent law provides that a patentee, that is the person applying for and receiving a patent, can be his own lexicographer (person who defines words). A patentee can use his or her own terms and define them for use in the patent as long as he or she remains consistent in his or her position. If an ambiguity exists, resort may be had to the common meanings of words contained in the patent application.

In your determination of the question of infringement, you must consider every element of the patent claims and must find that every one of them exists in the Defendant's article. The [5] absence of even one element avoids infringement. In other words, infringement must be direct—there must be the presence in the accused article of the elements claimed in the patent in suit. There can be no partial infringement.

Therefore, infringement is made out if the accused Flipak 14, Flipak 15 and Flipak 24 containers fall within the literal language of one or more of the claims of the Bockenstette patent. Question 1 of the questions to be answered by the jury is directed to this issue.